

Remarks

Claims 16-18 and 20-22 have been cancelled. Claims 4-5 and 8 -13 were cancelled previously in a Preliminary Amendment. Claims 1- 4, 7, 14, 15 and 19 remain in the application.

Traversal of Restriction Requirement

The Office entered an eleven-way restriction between Group I (Claims 1, 4 and 7, currently pending), Group II (Claims 8-10, previously cancelled), Group III (Claims 11-12, previously cancelled), Group IV (Claim 13, previously cancelled), Group V (Claims 14-15), Group VI (Claims 16-17, now cancelled), Group VII (Claim 18, now cancelled), Group VIII (Claim 19), Group IX (Claim 20, now cancelled), Group X (Claim 21, now cancelled), and Group XI (Claim 22, now cancelled). The Office stated the groups were distinct because Groups I, VI, and IX are drawn to distinct compounds. Groups II and VIII are drawn to a method to use the compounds of Group I; Group VII is drawn to a method of using the compounds of Group VI; and Groups X and XI are drawn to methods to use the compounds of Group IX. The Office also asserted that the Groups have acquired separate status in the art, and that a search of the Groups would not be co-extensive resulting in a serious burden on the examiner. After the current amendment, the only groups remaining are Groups I, V, and VIII.

Applicants traverse the restriction of the product from the process of using: Group I product from Group V and VIII methods. To find distinct inventions where claims are drawn to a product and a process of using the product, MPEP §806.05(h) states:

A product and a process of using the product can be shown to be distinct inventions if either or both of the following can be shown: (A) the process of using as claimed can be practiced with another materially different product, or (B) the product as claimed can be used in a materially different process.

The burden is on the examiner to provide an example, but the example need not be documented.

The Office gave as an example of another use for the product of Group I: “the nucleic acids of Group I can be used to produce the encoded protein, which in turn can be used for the production of antibodies.” Applicants respectfully submit that this example is not a bona fide, real-world “materially different process” for the use of the product. The example is non-specific and would be an insubstantial use of the product. The Office’s guidelines on specific utility for a product (“Revised Interim Utility Guidelines Training Manual”) state that the utility submitted must be credible, specific and substantial. Applicants submit that any example given by the Office to support the basis of a restriction requirement should meet the same standard. A generic use of a product that is non-specific and insubstantial does not meet the Office’s burden to give an example of a materially different process as required by M.P.E.P. §806.05(h).

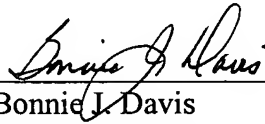
Applicants also respectfully submit that Group I should be rejoined with Group V. The Office did not give any reason why these two groups are distinct.

Additionally, if the restriction requirement is maintained between Group I and VIII, Applicants submit that the process claim of Group VIII, in which the independent claim include all the limitations of the product claim, should be rejoined pursuant to MPEP § 821.04 and the procedures set forth in the *Official Gazette Notice* dated March 26, 1996 (1884 O.G. 86). Section 821.04 states: “If applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined.”

Conclusion

Applicants provisionally elect with traverse Group I (Claims 1-4 and 7). Claims 5-6 and 8-13 were previously cancelled. Claims 16-18 and 20-22 have been cancelled by this amendment. Claims 1- 4, 7, 14-15, and 19 remain in the application. It is respectfully requested that the restriction requirement be reconsidered. and that Group I be rejoined with Groups V and VIII.

Respectfully submitted,



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